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ASA-672-02



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

23

In re Patent Application of

M. MORI et al

Serial No. 09/506,808

Group Art Unit: 3625

Filed: February 18, 2000

Examiner: C. Nguyen

For: AUTOMATIC AUCTION METHOD

PETITION FOR WITHDRAWAL OF NOTICE OF ABANDONMENT
(37 C.F.R. §1.181)

Commissioner for Patents
P.O. Box 1450
Washington, D.C. 22313-1450

May 8, 2003

RECEIVED

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GROUP 3600

Sir:

The Applicants have received a Notice of Abandonment dated March 24, 2003. The reason given for the holding of abandonment is as follows:

A reply was received on December 26, 2001... which is after the expiration of the period for reply (including a total Extension of Time of 3 month(s)) which expired on November 21, 2001.

The Applicants petition for withdrawal of the holding of abandonment for the reasons set forth below.

The submission of December 26, 2001 was timely filed.

As mentioned in the Notice of Abandonment, a Final Office Action was mailed on May 21, 2001, setting a shortened statutory period for response expiring August 21, 2001. A Notice of Appeal and a Petition for a Two-Month Extension of Time were filed October 22, 2001 (October 21 being a Sunday), generating a new due date of December 22, 2001, for further action.

On December 26, 2001, the Applicants filed a Reply under 37 CFR §1.116 and an Applicants Interview Summary Record summarizing an office interview conducted on December 18, 2001, and reflecting the Applicants' representative's belief that agreement was reached that the amendments in the Reply would be entered, the finality of the rejection would be withdrawn, and the rejection overcome (no Interview Summary was prepared by the Examiner). The Reply filed December 26, 2001 was timely in view of the due date (December 22) being a Saturday, the subsequent Monday (December 24) being a day on which the Federal Government executive branch departments and agencies were closed by order of the President, and the following Tuesday (December 25) being a Federal Government holiday.

Subsequently, following a request from the Examiner, copies of the Notice of Appeal and Petition for Extension of time filed October 22, 2001 were re-submitted by facsimile on January 2, 2002.

Copies of the following documents supporting the above explanation are attached to this petition:

Final Office Action cover sheet dated May 21, 2001;

Petition for Two-Month Extension of Time dated October 22, 2001; Notice of Appeal dated October 22, 2001; and date-stamped mailroom receipt showing USPTO receipt;

Reply under 37 CFR §1.116 dated December 26, 2001; Applicants Interview Summary Record dated December 26, 2001; and date-stamped mailroom receipt showing USPTO receipt;

Executive Order, "Closing of Federal Government Executive Departments and Agencies on Monday, December 24, 2001"; and

Notice of Abandonment dated March 24, 2003.

Prosecution History Subsequent to December 26, 2001

On May 2, 2002, the Examiner informed the Applicants' representative that "the Examiner considers that the pending application S.N. 09/506,808 is patentable, and currently under extra review before mailing further communication". An

Interview Summary to this end was sent by the Examiner via facsimile on May 7, 2002.

In response to repeated requests by the Applicants' representative, it was learned (on February 21, 2002), in a telephonic discussion, that an allowance had been counted as of January 28, 2002. Confirmation was provided by the Group Receptionist on March 14 and March 22, 2002, informing the Applicant's representative that the case was in "quality review" and that "no further follow up is needed".

Following the telephone interview of May 2, 2002, at the Examiner's request, the Applicants submitted a Terminal Disclaimer, disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of parent Patent No. 6,044,363. On August 22, 2002, a copy of the Terminal Disclaimer was re-transmitted at the Examiner's request.

During subsequent telephonic and e-mail correspondence, the Applicants' representative learned from the Examiner that Quality Assurance was interested in U.S. Patent No. 5,835,896 to Fisher et al, with respect to the patentability of the "allowed" claims. The Applicants were invited to amend the claims or provide arguments distinguishing the claims from

Fisher. However, the Applicants instead requested a written Office Action reopening prosecution.

Apparently, on February 24, 2003, the Examiner mailed an Advisory Action (a copy was sent via facsimile on March 21, 2003, after the Examiner learned that the original never arrived), noting as follows:

Applicant's reply has overcome the following rejection(s): rejection based upon Chavez et al.'s reference that teach (sic) away from this pending invention because of no true competitive state that requires a resolution disclosed by Chavez.... The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Although the terminal disclaimer (received on 8/21/02) overcomes double-patenting rejections, the rejections ... using Fisher et al (U.S. Pat. 5,835,896) would be applicable to pending independent claims.

The Applicants note that there is no pending rejection involving Fisher. Fisher, as mentioned above, was raised by Quality Assurance as an objection to permitting the "allowed" claims from advancing to issue.

The Examiner mailed the Notice of Abandonment on March 24, 2003, as mentioned above.

Copies of the following documents supporting the above explanation are attached to this petition:

Interview Summary of telephone interview of May 2, 2002, sent via facsimile by the Examiner on May 7, 2002;

Transmittal of Terminal Disclaimer and Terminal Disclaimer dated August 21, 2002, and date-stamped mailroom receipt showing USPTO receipt; and

Advisory Action dated February 24, 2003.

Relief Sought by Applicants

In view of the foregoing, the Applicants petition for the following:

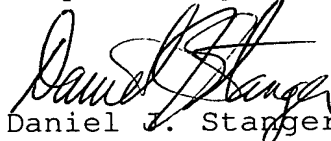
- 1) Acknowledgement that the Notice of Appeal filed October 22, 2001 has been received and entered.
- 2) Acknowledgement that the Reply filed December 26, 2001 was timely, and has been entered and considered.
- 3) Withdrawal of the finality of the Office Action mailed May 21, 2001, in light of the Examiner's indication that all issues raised in the Final Office Action have been withdrawn.

Additionally, the Applicants request:

- 1) Issuance of a Notice of Allowance and Notice of Allowability indicating allowance of claims 16-33 as amended on December 26, 2001; or, in the alternative
- 2) Issuance of a new, non-final Office Action providing a written objection or rejection of the claims, to which the Applicants will have a full and fair opportunity to respond.

It is believed that no fee is due in conjunction with the filing and consideration of this petition. However, if any fee is determined to be due, the Commissioner is authorized to charge the fee to Deposit Account No. 50-1417.

Respectfully submitted,



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